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PATENT, TRADEMARK AND COPYRIGHT LAW
AND RELATED FEDERAL AND ITC LITIGATION



Docket: 0039-5461-2

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WASHINGTON, D.C. 20231

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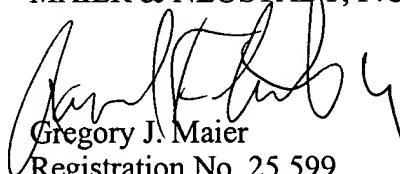
MAY 11 1999

REPLY BRIEF UNDER 37 CFR §1.193(b) AND REQUEST
FOR COMPLIANCE WITH MPEP §1003(10) AND §1208 (in triplicate) TECHNOLOGY CENTER 2800
REQUEST FOR ORAL HEARING

Our check in the amount of \$ 260.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

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0039-5461-2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

TAKANOBU KAMAKURA

: EXAMINER : WILLE

SERIAL NO: 08/578,980

:

FILED: DECEMBER 27, 1995

: GROUP ART UNIT: 2814

FOR: SEMICONDUCTOR LIGHT
EMITTING DEVICE

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COMPLIANCE WITH MPEP §1003(10) AND MPEP §1208

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WASHINGTON, D.C. 20231

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SIR:

The present Reply Brief is presented in order to point out and respond to several new points of argument and new interpretations of law raised in the Examiner's Answer of March 4, 1999.

1. NEW INTERPRETATION AND/OR APPLICATION OF 35 U.S.C. §102 NOT PROPERLY APPROVED UNDER MPEP §1003(10) AND MPEP §1208

Page 8 of the Answer (at lines 19 and 20) appears to finally admit that "the strain layer [27 of Scifres] cannot protect the portion of the clad layer [25] outside [of the strain layer 27]." Even though stating that this "is true," the Answer nevertheless maintains the 35 U.S.C. §102 rejection of Claims 1, 3, and 5 under what can only be considered a clearly new interpretation and/or application of this section that permits positive claim limitations to be

ignored if the examiner concludes that they are “immaterial” because the examiner believes that the prior art reference achieves at least a comparable result without use of such limitations. Here, the Answer asserts that it is only “the inner region where the active layer is that needs protection” (page 8, line 20 - page 9, line 1) and “that it is the active region that must be protected and defects in the clad region would be relatively innocuous if they didn’t migrate to the active layer (page 9, line 4) as the apparent reason that the claim limitations as to placement of the dense defect layer and its role in protecting all parts of the hetero-configuration including both clad layers can be ignored.

Thus, the new interpretation and/or application of 35 U.S.C. §102 is clearly based upon a rationale that it is no longer necessary that an applied 102 reference disclose, expressly, or under the doctrine of inherency, each and every element of the claimed invention as well as disclosing structure which is capable of performing all recited functional limitations. Instead, the examiner’s new interpretation and or application of this part of the statute permits the examiner to treat a limitation as being, in effect, not present if it is deemed to be “immaterial” because the examiner has an undocumented and subjective belief that the limitation adds nothing substantial in terms of improved performance as compared to the device of the prior art reference.

This rationale permitting a positive claim limitation to be ignored looks to appellant to be suspiciously similar to the long discredited practice of attempting to ignore claim limitations that the PTO has pronounced to be deficient under 35 U.S.C. §112. Note In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) HOLDING that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art” and MPEP §2173.06. Moreover, note In re Wilder, 166 USPQ 545, 548, (CCPA 1970) requiring that

every word in a claim must be given effect. Finally, the PTO has in the past presented a similar position in In re Ratti 123 USPQ 349, 352-53 (CCPA 1959) and was informed that:

If we may extract from the foregoing what we understand to be the essence of the board's position in the matter, it is that claim 10 is not patentable, though it defines a combination which is novel over the disclosures of the references, because the claimed combination has not been shown to be any better than, or to possess any advantage over, what was known to the art.

[5][6] As was pointed out in In re Stempel, Jr., 44 CCPA 820, 241 F.2d 755, 113 USPQ 77, an applicant is entitled to a patent, under the statutes, unless one of the prohibitory provisions of the statutes applies. The statutory requirements for patentability, broadly stated, are novelty, usefulness and unobviousness, as provided in 35 U.S.C. sections 101, 102, and 103. While it is true that proof that an invention *is* better or *does* possess advantages may be persuasive of the existence of any one or all of the foregoing three requirements, and hence be indicative of patentability, Congress has not seen fit to make such proof a prerequisite to patentability (Footnote omitted).

In any event, the ignoring of a claim limitation in a rejection under 35 U.S.C. §102 is a clear departure from court established criteria, as set forth, for example, by RCA Corp. v. Applied Digital Data Systems, Inc., 221 USPQ 385, 388 (Fed. Cir. 1984) (cited at page 4 of the Brief). In addition note is taken of published PTO directives in the of MPEP, such as MPEP §2131(July 1998) at page 2100-63 under the heading "**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**" as well as MPEP §1208(July 1998) at page 1200-17 noting the requirement that "the examiner's answer, or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection" (emphasis added).

Therefore, since the Answer sets forth a new interpretation and/or application of 35 U.S.C. §102, the Answer must also contain the initial Group Director approval indicated at

Pages 1200-15 and 16 of MPEP §1208(July 1998) as to this “new interpretation or application of the existing patent law” under MPEP § 1003 and §1208, not to mention the required final approval noted at page 1200-16 of MPEP §1208(July 1998) relative to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. Verification of these approvals which are not apparent on the record is, therefore, requested.

2. RESULTS OF THE NEW POINTS RAISED IN THE ANSWER

In any event, the Answer admits that it improperly ignores the words of Claim 1 and that Scifres does not teach that all of the hetero-configuration limitations including that the dense layer must be outside each of the clad layers as well as the active layer, the rejection must be reversed as being based on a clearly erroneous court required interpretation of 35 U.S.C. § 102. Since Claims 3 and 5 depend on Claim 1, the reversal of the rejection as to these claims is also in order.

Further compounding the disregard for established law in the Answer is the apparent belief that the 35 U.S.C. §102 rejection of claim 5 and its recited “buffer” layer can, in the Answer, be modified to a 35 U.S.C. §103 rejection over Scifres in view of Sugawara as page 10 of the Answer attempts. Perhaps the examiner has decided to withdraw the 35 U.S.C. §102 rejection of Claim 5 in favor of the 35 U.S. C. §103 rejection thereof. If this is the intent, such a withdrawal should be made clear.

In addition to improperly arguing that the PTO may choose which words of the claims are to be given weight and then make an anticipation rejection under 35 U.S.C. §102 based upon a reference which does not disclose, expressly, or under the doctrine of inherency, each and every element of the claimed invention as well as disclosing structure which is capable

of performing all recited functional limitations based upon a reference, the Answer admits that “for the [Scifres] strain layer to be effective, it must be enclosed in a three layer sandwich, exactly as Scifres shows” (Answer, page 9). This admission clearly eliminates any question of obviousness in terms of base Claims 1, 6, and 7 and the artisan having any reasonable basis for providing the Scifres strain layer outside the clad layer between the “first electrode and the layers of the hetero-configuration,” as these base claims all require.

Accordingly, this further admission of the Answer establishes the non-obviousness of the subject matter of independent Claims 1, 6, and 7 as well as the claims dependent thereon.

Turning to the error noted at the top of page 10 of the Brief, it is noted that “roosed” should be --forced-- and that “art” should be --part--.

3. ESTABLISHING WELL KNOWN PRIOR ART

The Answer (pages 7-8) is noted to clearly improper present unsupported opinion as to the present day state of the art instead of any evidence of the state of the art on December 27, 1995, applicant’s filing date and the date of concern as to determining obviousness.

Whatever is known as of “now” is, thus, of no concern in this appeal. To the extent that the PTO intends to rely on any of the opinion statements as to the state of the art as of the filing date, Applicant notes that unsupported assertions of what was known in the art will not due and calls for documentation under MPEP §2144.03. Note also In re Barr, 170 USPQ 330, 333 (CCPA 1971) and the indication therein that the citation of even two patents is not weighty evidence of art recognition.

In addition, even if each of the allegations of pages 7 and 8 were to be proven, which they have not, it is well established that merely showing something was known does not establish a reasonable basis as to why the artisan would use this known technology to modify some other reference. Note In re Warner, 154 USPQ 173, 177 (CCPA 1967) (“[Whether the individual elements of a combination are old ‘begs the question,’] as “if such a combination is novel, the issue is whether bringing them together ... was obvious in light of the prior art.”). The apparent assumption that merely establishing something is known establishes motivation to use it to modify a reference at page 12 of the Answer is further clear error in view of the established case law.

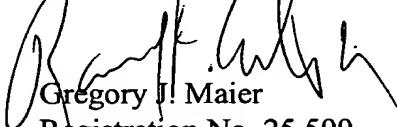
Turning to Inoue, the arguments at pages 10 and 11 of the Answer appear to be again be contrary to established law in suggesting that just a layer characteristic can be extracted from Inoue without regard to a consideration of this reference as a whole. Even the MPEP, which examiners are supposed to follow, notes the clear error of such a position at MPEP § 2141.02 (July 1998) at page 2100-109 under the heading **“PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.”** As noted in the Brief, there is no logical basis to suggest that the artisan would look to the defect canceling layers of Inoue to modify the defect blocking layers of Scifres.

CONCLUSION

In light of the above, the reversal of all applied grounds of rejection is respectfully submitted to be in order and respectfully requested.

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